



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,769	01/21/2000	Pierre Sabatier	160383.90121	4877
26710	7590	03/04/2004	EXAMINER	
QUARLES & BRADY LLP 411 E. WISCONSIN AVENUE SUITE 2040 MILWAUKEE, WI 53202-4497			LIN, KENNY S	
		ART UNIT		PAPER NUMBER
		2154		
DATE MAILED: 03/04/2004				

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/488,769	SABATIER ET AL.	
Examiner	Art Unit		
Kenny Lin	2154		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 December 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 12-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 12-21 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

1. Claims 12-21 are presented for examination. Claims 6-11 have been canceled by the applicant.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon, US 5,974,043, in view of Szviatovszki et al (hereinafter Szviatovszki), US 6,470,010.

4. Solomon and Szviatovszki were cited in the previous office action.

5. As per claim 12, Solomon taught the invention substantially as claimed including a process for establishing communication between a first device and a second device on a computer network of the Internet type (Internet, WAN), wherein the first device and the second device are also operable on a telephone network (PSTN), the process comprising:

- a. The first device calling the second device on the telephone network to invite the second device into the said communication by giving it the references of a message accessible on the computer network (col.4, lines 4-9), and

b. the second device connecting itself to the computer network, to access the aforesaid message, to obtain the computer address of the calling device and to establish communication with the calling device (col.4, lines 15-21).

6. Solomon did not specifically teach the first device to connect to the computer network to receive a computer address and to incorporate it into the aforesaid message. However, Szviatovszki taught the first device connecting to the computer network, to receive a computer address and to incorporate it into the aforesaid messages (col.4, lines 33-51, col.5, lines 11-25). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Solomon and Szviatovszki because Szviatovszki's teaching of incorporating address, identification and network service number into message would properly store/keep record of the caller's routing information in Solomon's computer network communication establishing process and use the information to enable communications.

7. As per claim 15, Solomon and Szviatovszki taught the invention substantially as claimed in claim 12. Solomon further taught that the first device calls the second device on the telephone network prior to connecting to the computer network (col.4, lines 4-6).

8. As per claims 13 and 16, Solomon and Szviatovszki taught the invention substantially as claimed in claims 12 and 15. Solomon further taught that in which the first device calling the second device via the telephone network, sends the second device a secret code word, which the

second device subsequently retransmits via the computer network to the first device, so that the first device may agree to establish communication on the computer network (col.19, lines 8-21).

9. As per claims 14 and 17, Solomon and Szviatovszki taught the invention substantially as claimed in claims 12 and 15. Szviatovszki et al further taught that during the call via the telephone network, the first device and the second device exchange signals to verify their compatibility for communication across the computer network (col.2, lines 60-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Solomon and Szviatovszki because Szviatovszki's teachings of exchanging compatibility for communication ensure that the devices are compatible for communication.

10. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon, US 5,974,043, in view of Szviatovszki et al (hereinafter Szviatovszki), US 6,470,010, as applied to claim 12 above, and further in view of "Official Notice".

11. As per claim 18, Solomon and Szviatovszki taught the invention substantially as claimed in claim 12. Solomon further taught that the first device calls the second device on the telephone network prior to connecting to the computer network (col.4, lines 4-6). Solomon and Szviatovszki did not specifically teach that the first device connect to the computer network to receive a computer address and incorporates it into the message accessible on the computer network prior to calling the second device on the network. However, it would have been obvious

to have the first device connect to the computer network to receive and incorporate a computer address into a message prior to calling the second device since this particular step order derives to the same result as having the first device calling the second device first. Official Notice is taken that the concept and advantage of changing around the order of the procedures that does not affect the result in the processes is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use both step orders in performing Solomon and Szviatovszki's communication establishing process according to one's preferences since both step orders direct to the same result in performance.

12. As per claim 19, Solomon and Szviatovszki taught the invention substantially as claimed in claim 18. Solomon further taught that in which the first device calling the second device via the telephone network, sends the second device a secret code word, which the second device subsequently retransmits via the computer network to the first device, so that the first device may agree to establish communication on the computer network (col.19, lines 8-21).

13. As per claim 20, Solomon and Szviatovszki taught the invention substantially as claimed in claim 18. Szviatovszki et al further taught that during the call via the telephone network, the first device and the second device exchange signals to verify their compatibility for communication across the computer network (col.2, lines 60-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Solomon and Szviatovszki because Szviatovszki's teachings of exchanging compatibility for communication ensure that the devices are compatible for communication.

14. As per claim 21, Solomon and Szviatovszki taught the invention substantially as claimed in claim 20. Szviatovszki et al further taught that the signals contain an identifier of the first device (col.5, lines 35-43, 46-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Solomon and Szviatovszki because Szviatovszki's teaching of having an identifier of the first device within the signals enables the receiver side to recognize which device is transmitting the signals.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bellin, US 6,346,890.

McKinnon et al, US 6,175,565.

16. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (703)305-0438. The examiner can normally be reached on 8 AM to 5 PM Tuesday to Friday and every other Monday.

Art Unit: 2154

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703)305-8498. Additionally, the fax numbers for Group 2100 are as follows:

Official Responses: (703) 872-9306

ksl
February 24, 2004


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100